REMARKS

Claims 1-75 are pending in the case. The Office Action rejected each of claims 1-75. More particularly, the Office Action rejected:

- claims 1-75 as "vague and indefinite" under 35 U.S.C. § 112, ¶2, for several different reasons; and
- claims 1-75 as anticipated under 35 U.S.C. § 102 (b), by U.S. Letters Patent 6,043,867 ("Saban") or U.S. Letters Patent 5,631,653 ("Reedy").

Applicant traverses each of the rejections.

I. INFORMALTIES

Applicant notes that the Office Action contains no indication as to whether the drawings were accepted or objected to. Applicant requests clarification on this matter.

II. CLAIMS 1-75 ARE IN CONDITION FOR ALLOWANCE

As noted above, the Office Action rejected the claims on two separate grounds. First, claims 1-75 as "vague and indefinite" under 35 U.S.C. § 112, ¶2, for several different several different reasons varying by claim. Second, the Office Action rejected claims 1-75 as anticipated under 35 U.S.C. § 102 (b), by U.S. Letters Patent 6,043,867 ("Saban") or U.S. Letters Patent 5,631,653 ("Reedy"). Applicant traverses the rejection and addresses each statutory ground of rejection in turn.

A. Claims 1-75 are Definite

The Office Action rejected claims 1-75 as "vague and indefinite" under 35 U.S.C. § 112, ¶2, for several different reasons varying by claim. In particular, the Office Action alleges that:

- the limitation "determining a pattern" in independent claims 1, 18, 34, 50, 65, and 75 is vague and indefinite;
- the limitation "assuming a value" in claims 2, 19, and 51 is vague and indefinite; and
- claims 6, 23, 59, 67, and 69 are claimed in the alternative, and therefore indefinite.

Applicant respectfully submits that each of these rejections is improvident.

1. Claims 1, 2, 18, 19, 34, 50, 51, 65, and 75 Are Definite in Light of the Specification

The Office Action rejected claims 1, 2, 18, 19, 34, 50, 51, 65, and 75 as indefinite as follows:

- the limitation "determining a pattern" in independent claims 1, 18, 34, 50, 65, and 75 is vague and indefinite; and
- the limitation "assuming a value" in claims 2, 19, and 51 is vague and indefinite.

These terms, when construed as by one of ordinary skill in the art and in light of the specification, are definite.

Admittedly, in the abstract, the term "pattern" has many meanings. For instance, the word "pattern"—alleged to be indefinite here—used as a noun, can be defined as follows:

> **1. a.** An archetype. **b.** An ideal worthy of imitation: *a pattern of womanly virtues*. **2.** A plan, diagram, or model to be followed in making things: *dress patterns*. **3.** A representative sample; specimen. **4. a.** An artistic or decorative design: *a paisley*

> *pattern*. **b**. A design of natural or accidental origin: *snowflake patterns*. **5**. A composite of traits or features characteristic of an individual: *behavioral patterns*. **6**. Form and style in an artistic work or body of artistic works. **7**. **a**. The configuration of identically aimed rifle shots upon a target. **b**. The distribution and spread of shot from a shotgun. **8**. Enough material to make a compete garment. **9**. A standardized diagram transmitted to test television picture quality. **10**. The ordered flight path of an aircraft about to land.

The American Heritage Dictionary, p. 911 (Houghton Mifflin Co. Boston 1982). Thus, presumably, the Office's rhetorical question, "What is forming the pattern and what type of pattern is being formed?"

However, claims are not construed in the abstract. Claims are to be construed as by one of ordinary skill in the art. Claims are also to be construed in light of the specification. As the Office admits:

> The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:
>
> (A) *The content of the particular application disclosure*;
>
> (B) The teachings of the prior art; and
>
> (C) The claim interpretation *that would be given by one possessing the ordinary level of skill in the pertinent art* at the time the invention was made.

M.P.E.P. § 2173.02 (emphasis added). "During patent examination, the pending claims must be given the broadest reasonable interpretation *consistent with the specification*." M.P.E.P. § 2173.05 (a) (emphasis added).

Applying these principles, the limitation "determining a pattern" takes on striking clarity. One skilled in the art would immediately eliminate most of the spurious definitions of pattern when construing this limitation within the context of the art. For instance, one skilled in the art could immediately eliminate meanings such as "[a] standardized diagram transmitted to test

television picture quality" found in the definition quoted above. It is readily apparent in the context of the art and in light of the specification that the "pattern" is a "search pattern." (specification, p. 8, lines 17-20; p. 11, lines 15-23; p. 12, lines 7-12; FIG. 4B and associated text; FIG. 5 and associated text) It is also readily apparent that the "what is forming the pattern" is some kind of computing device. (FIG. 8A – FIG. 8D & FIG. 9 and associated text on pp. 17-18)

The Office's position regarding "ascertain" is similarly flawed. The Office alludes to but one meaning for the term "ascertain." However, it is clear from the specification that Applicant employs a broader meaning. For instance, at p. 10, lines 28-30, the specification states:

> The invention also admits wide variation in the manner in which the target information is ascertained. Some implementation will simply assume values for one or more of the TLE, target heading, and target speed.

And, at p. 13, lines 3-8:

> Thus, it is desirable to ascertain a true heading 210 instead of assuming one. Note, however, that assuming the heading does not prevent implementation of the present invention, but merely affects the orientation of the pattern relative to the target's heading. Similarly, knowing the target's speed is also desirable, as it permits a smaller TLE 420, but a target speed may be assumed and reflected in a larger magnitude for the TLE 420.

And at p. 17, lines 8-9:

> Other aspects of the invention are similarly subject to variation. Other than the target location, the target information may be ascertained by observation or assumed at some value.

Thus, it is clear from the specification that Applicant is using a meaning for the term "ascertain" broader than the one chosen by the Office. Furthermore, Applicant notes that there is no *evidence* of record that the term "ascertain" is limited to the meaning selected by the Office and excluding that used by Applicant.

Applicant therefore respectfully submits that the cited limitations are definite when construed under properly applied canons of claim construction. More particularly, when construed as by one of ordinary skill in the art in light of the specification, the limitation more than adequately "clearly and distinctly points out" what Applicant considers to be his invention. "The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." M.P.E.P. 2173.02. Applicant therefore requests that these rejections be withdrawn.

2. Claims 6, 23, 59, 67, and 69 are Definite Despite Being Claimed in the Alternative

Claims 6, 23, 59, 67, and 69 were rejected as indefinite as being claimed in the alternative. However, it is well settled that claiming in the alternative does not render a claim indefinite *per se*. Per the Office, "Applicant may use functional language, *alternative expressions*, negative limitations, *or any style of expression of format of claim which makes clear the boundaries of the subject matter for which protection is sought.*" M.P.E.P. § 2173.01 (emphasis added). More particularly:

> Alternative expressions using "or" are acceptable, such as "wherein R is A, B, C, or D." The following phrases were each held to be acceptable and not in violation of 35 U.S.C. 112, second paragraph in *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975): "made entirely or in part of" "at least one piece" and "iron, steel or any other magnetic material."

M.P.E.P. § 2173.05 (i), p. 2100-202. The Office provides no reason why the alternative claiming formats in the cited claims are vague. Thus, the rejection constitutes a rejection of alternative claiming formats *per se*, in contravention of Office policy evidenced in the M.P.E.P. passages cited above. Applicant therefore requests these rejections also be withdrawn. At a minimum, Applicant requests some clarification as to why the Office believes them to be indefinite.

B. Claims 1-75 are Novel over Saban and Reedy

The Office Action rejected claims 1-75 as anticipated under 35 U.S.C. § 102 (b), by U.S. Letters Patent 6,043,867 ("Saban") or U.S. Letters Patent 5,631,653 ("Reedy"). Applicant traverses this rejection on two grounds. First, the Office failed establish *prima facie* that the claims are anticipated. Second, Saban and Reedy fail disclosed each limitation of the independent claims in the relationship in which they are claimed.

1. <u>The Office Failed In Its *Prima Facie* Proof</u>

"It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) quoting *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967); *Ex parte Skinner*, 2 U.S.P.Q.2d (BNA) 1788, 1788-89 (Bd. Pat. App. & Int. 1987). An anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990). "[I]t is incumbent upon the [Office] to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990).

It is this last requirement that the Office fails to meet in the present case. The entire statement of the rejection is:

> Claims 1-75 are rejected under 35 U.S.C. 102(b) as being anticipated by either one of Saban or Reedy.
>
> See especially column 12, lines 10-45 of Saban and column 4, line 40 – column 8, line 60 [of Reedy].

Thus, the Office summarily points to selected portions of the references without ever pointing out where even a single limitation of a single claim is disclosed within those portions. How can Applicant be expected to evaluate the reasonableness and/or correctness of the construction of the references if the construction is not even put forth? Applicant respectfully submits that the Office failed to meet the standard of *Levy*.

2. Saban and Reedy Fail to Disclose Every Limitation of the Claims

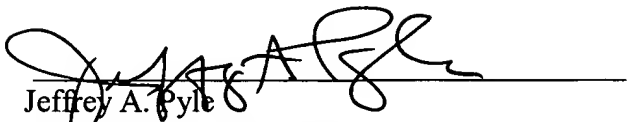
As noted above, an anticipating reference, by definition, must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990). Applicant respectfully submits that both Saban and Reedy fail to meet this standard and, therefore, do not anticipate any of claims.

Each of the independent claims recites a limitation approximating "autonomously determining a pattern." (cl. 1, line 4; cl. 18, line 4; cl. 34, line 7; cl. 50, line 7; cl. 65, lines 8-9; cl. 75, line 5). As noted above, the Office has failed to identify any teaching of this limitation in either Saban or Reedy. Applicant's review has not found any. If the Office maintains that this limitation is taught by either Saban or Reedy, Applicant requests clarification permitting rebuttal by Applicant. Otherwise, Applicant requests the rejection be withdrawn.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and requests they be allowed to issue. The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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